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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,624	05/08/2001	Paul Raposo		3680

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,624

Applicant(s)

RAPOSO, PAUL

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-14 are presented for examination.

Claim Objections

2. Claims 1, 12, and 14 are objected to because of the following informalities:

Claim 1, line 1: Should "versions...is benchmarked" read as "versions...are benchmarked" or "a version...is benchmarked"?

Claim 12, line 2: Should another word (e.g., "data" or "information") follow "demographic"?

Claim 14, line 1: Should "are panelists" be deleted?

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Claim 1 is directed toward a system, but comprises no system elements *per se*; therefore, it is not clear which statutory class it or dependent claims 2-7 are limited to.

Furthermore, the "survey builder" recited in claim 7 is interpreted as software *per se*, which is non-statutory.

While claims 8-14 produce a useful, concrete, and tangible result, the recited steps could be performed entirely by hand and are therefore not limited to the technological arts.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed,

had possession of the claimed invention. Also, claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as intended by Applicant.

Claims 1-14 recite the benchmarking of versions of a survey, creating a benchmark, storing a benchmark, etc. The specification lacks adequate written disclosure to explain what is meant by benchmarking versions of a survey. Are the survey results used to measure the success of benchmarked goals of a survey requester or does the actual survey itself comprise various versions that are all compared to an original version? The specification states, "Benchmarks provide a quantifiable way to conceptually grade and measure the success of a survey against goals." (Page 2 of the specification) Again, is the success of a survey measured or do the results of the survey reflect the success of an entity in reaching established goals related to survey questions?

Also, what is meant by designing a survey with goals and weights (see claims 8-14)? Are survey questions literally weighted to reflect a level of importance or are they merely chosen to correspond to the information that a survey requester desires to ascertain from the survey results?

Without adequate written disclosure regarding the aforementioned questions, the Examiner submits that one of ordinary skill in the art would not know how to make and/or use the claimed invention, as intended by Applicant.

Appropriate clarification is required.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed toward a system; however, no system elements are recited. As a matter of fact, the claim appears to have no body. In light of these two problems, it is not clear that the recited "whereby" clause merits patentable weight.

In line of claim 1, it is not clear what is meant by benchmarking versions of a survey. Are the survey results used to measure the success of benchmarked goals of a survey requester or does the actual survey itself comprise various versions that are all compared to an original version?

Claims 4-6 are directed toward the "server of claim 2." Are claims 4-6 systems claims or are they only meant to be directed toward the server of claim 2? In other words, are claims 4-6 intended to incorporate all of the limitations of claims 1 and 2?

Claim 6 recites "a client respondent/other data database." Does this database contain client respondent data, other data, or both client respondent and other data? Also, does "other data" refer to any other type of data distinct from client respondent data?

Claims 2-7 are dependent from claim 1 and therefore inherit the same rejections under 35 U.S.C. § 112, 2nd paragraph.

In claim 8, what is meant by designing a survey with goals and weights? Are survey questions literally weighted to reflect a level of importance or are they merely chosen to correspond to the information that a survey requester desires to ascertain from the survey results?

Claims 9-14 are dependent from claim 8 and therefore inherit the same rejections under 35 U.S.C. § 112, 2nd paragraph.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-9 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas (US 2002/0002482).

Thomas discloses a survey system:

[Claim 1] whereby versions of a survey is benchmarked (¶¶ 37, 77);

[Claim 2] comprising:

(a) a secure server (¶¶ 35, 65);

(b) a server web site (¶¶ 35, 48, 51);

[Claim 3] further comprising a client web site (¶¶ 48, 51);

[Claim 4] further comprising a member database (¶¶ 52-53 – In order to communicate survey results to a survey requester, a database containing survey requester, i.e., member, contact information must be maintained);

[Claim 5] further comprising a respondent database (¶¶ 29-30);

[Claim 6] further comprising a client respondent/other data database (¶¶ 29-30, 52-53);

[Claim 7] further comprising a survey builder (¶¶ 30, 57-60).

Thomas discloses a method of taking a survey whereby a benchmark is maintained comprising the steps of:

[Claim 8] (a) designing a survey with goals and weights (¶¶ 5, 7, 30, 57-60);

(b) releasing said survey (¶¶ 57-66);

(c) creating a benchmark based on survey results (¶¶ 37, 77);

(d) storing said benchmark associated with said survey (¶¶ 37, 77);

[Claim 9] selecting demographics for a survey target (¶¶ 29-30, 37, 47, 56, 72, 76);

[Claim 11] wherein said survey results are obtained from a plurality of individuals who have entered into an agreement to respond to surveys (¶ 29, 72-75);

[Claim 12] wherein said individuals are respondent members, having provided demographic along with said agreement (¶¶ 29-30, 37, 47, 56, 72, 76);

[Claim 13] wherein said individuals are panelists, having been selected based on particular characteristics (¶¶ 29-30, 37, 47, 56, 72, 76);

[Claim 14] wherein said individuals are panelists are compensated for the participation (¶¶ 29, 73).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US 2002/0002482), as applied to claim 8 above.

[Claim 10] While Thomas supplies survey requesters with survey results and correlations between these results and participant categories (¶¶ 52-53), Thomas does not expressly teach that these results are presented by generating a graph based on a benchmark. However, Official Notice is taken that it is old and well-known in the art of survey analysis to present survey results by generating a graph based on a benchmark. Such an analysis facilitates a quick and convenient visual assessment of how successful a survey requester has been in achieving goals that his/her survey aimed to evaluate. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Thomas to provide its survey results by generating a graph based on a benchmark in order to facilitate a quick

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and convenient visual assessment of how successful a survey requester has been in achieving goals that his/her survey aimed to evaluate.

Remarks

13. It is called to applicant's attention that if a communication is deposited with the U.S. Postal Service and mailed to the Office by First Class Mail before the reply time has expired, applicant may submit the reply with a "Certificate of Mailing" which merely asserts that the reply is being mailed on a given date. So mailed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, DC 20231
on _____(date).

Typed or printed name of person signing this certificate

Signature _____

Date _____

14. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. ***Applicant is strongly advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution.*** The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

15. Applicant is also invited to peruse information regarding the patent process on the Patent Office's web site: <http://www.uspto.gov>. In addition to being able to download the Manual of Patent Examining Procedure (MPEP), the Applicant may also access needed forms as well as useful fee and patent prosecution information.

Conclusion

16. Applicant is reminded that the shortened statutory period for response to the present Office action on the merits is set at THREE MONTHS (please see MPEP 710.02(b)). If needed, the Applicant may request an extension of time up to, but no more than, SIX MONTHS from the MAILING DATE listed on the cover letter accompanying the Office action. If no proper response is received from the Applicant within six months from this mailing date, the present application will be abandoned. Please read MPEP 710 in its entirety (including MPEP 710.01 through 710.06) to learn more about statutory periods for responses and how to obtain an extension of time, if necessary (e.g., there is a corresponding fee for each month the response time is extended beyond the three-month statutory reply period granted for a response to non-final Office action).

17. This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Abelow (U.S. Patent No. 5,999,908) – Discloses the refinement of product designs through continuous customer product evaluations.

Ghahramani (U.S. Patent No. 5,808,908) – Discloses the surveying of users to assess usability performance indicators, including goals achievement indicators.

Powers et al. (U.S. Patent No. 6,604,084) – Discloses the automatic generation of survey questions based on the desired goals of a performance evaluation.

D'Alessandro (U.S. Patent No. 6,556,974) – Discloses the use of survey results to evaluate current business performance.

West et al. (U.S. Patent No. 6,175,833) – Discloses the use of a survey editor to update the questions used in a survey.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.



Susanna M. Diaz
Primary Examiner
Art Unit 3623
September 27, 2004

37 CFR § 1.105 - Requirement for Information

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

2. The information is required to identify products and services embodying the disclosed subject matter of "The Survey System" (discussed on pages 3-4 of the specification). The specification describes "The Survey System" as "a turnkey market research application, available as a subscription-based service through secure Internet access" (page 3). The Examiner has located various references that describe "The Survey System," including the following:

Dysart ("The Survey System 7.0: A Tool for Novices, Experts")

Creative Research Systems web site, archived on [URL:

http://web.archive.org/web/*/http://www.surveysystem.com] from February 21, 1999 through May 4, 1999, retrieved on September 13, 2004.

Creative Research Systems web site, archived on [URL:

http://web.archive.org/web/*/http://www.surveysystem.com] from November 14, 1999 through April 19, 2000, retrieved on September 24, 2004.

"The Survey System" is a service offered by Creative Research Systems, which does not appear to be directly affiliated with the Applicant. Therefore, the Examiner requests information regarding the differences, if any, between Applicant's invention, as

both disclosed and claimed, and "The Survey System." For example, is Applicant's invention derived from the service offered by "The Survey System"? If so, how has Applicant modified "The Survey System" to produce the invention?

3. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

4. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

5. This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this

requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

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Susanna Diaz

Susanna M. Diaz
Primary Examiner
Art Unit 3623
September 27, 2004

*SPE signature
was included in original
sent to Applicant*

SMD